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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/730,459

12/08/2003

Mark J. Levine

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EXAMINER

PIZIALI, ANDREW T

ART UNIT

PAPER NUMBER

1771

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|-----------|---------------|
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3 MONTHS

01/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/730,459 | LEVINE ET AL. | |
| | Examiner | Art Unit | |
| | Andrew T. Piziali | 1771 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 23-30 is/are pending in the application.
- 4a) Of the above claim(s) 3,5,9-12,24,28 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6-8,13,14,23,25-27 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/14/04 & 3/23/06 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/29/2006 has been entered.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1, 2, 4, 6-8, 13, 14, 23, 25-27 and 30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to both a device (apparatus) and (in combination with) a support fabric (product) while also claiming method of making and/or method of using steps. The claimed invention does not fall within one of the four categories of patent eligible subject matter recited in 35 USC 101. It is noted that the applicant elected product claims in the election made on 10/21/2005.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 2, 4, 6-8, 13, 14, 23, 25-27 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 2, 4, 6-8, 13, 14, 23, 25-27 and 30, it is unclear if the applicant is claiming a product, a process of making, an apparatus, or a process of using.

Regarding claims 1, 2, 4, 6-8, 13 and 14, a single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph (see MPEP 2173.05 (p)).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-2, 4, 6-8, 13, 23 and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,498,468 to Blaney.

Regarding claims 1-2, 4, 6-8, 13, 23 and 25-27, Blaney discloses a fabric comprising flattened filaments (see entire document including column 5, lines 10-19, column 6, lines 33-37, column 10, lines 1-21 and lines 49-60, and Figures 4, 6, 8 and 10). Blaney does not appear to

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specifically mention using the fabric as a supporting fabric, to form a nonwoven product and thereafter removing the nonwoven product from the supporting fabric, but it appears that the fabric is capable of being used as claimed. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Regarding the claimed hydroentangling device, Blaney discloses that high-pressure water jets may be present to soften the fibrous matrix after the flattening force is applied (column 5, lines 28-34). Therefore, Blaney discloses a hydroentangling device in combination with the disclosed fabric.

Regarding claims 2 and 4, Blaney discloses that at least one direction (CD or MD) of filaments may include one or more secondary filaments (column 6, lines 4-6).

Regarding claim 6, Blaney discloses that the flattened filaments may include a combination of the MD and CD filaments (column 6, lines 33-37 and column 9, line 57 through column 10, line 21).

Regarding claims 7 and 8, Blaney discloses that the fabric may be a double layer fabric comprising a woven layer and a nonwoven layer wherein the flattened filaments of the woven layer are incorporated only in the woven layer (column 6, lines 33-37). Regarding the claimed use of the woven layer as the wear side layer, it is submitted that woven layer is capable of being used as the wear side layer.

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Regarding claim 13, Blaney discloses that fabric maintains permeability (column 1, lines 19-28). Considering that the fabric disclosed by Blaney is substantially identical to the claimed fabric (permeable woven fabric comprising flattened filaments), and considering that the applicant discloses that such a fabric inherently possesses the claimed permeability (see page 11, lines 8 and 9 of the current specification), it appears that the fabric inherently possesses the claimed permeability.

The Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977).

Regarding claims 23 and 25-27, Blaney discloses that the flattened filaments may be calendered and then woven or the fabric may be woven and then the fabric can be calendered (column 9, line 57 through column 10, line 21).

Regarding claim 27, Blaney does not appear to mention calendaring just one side of the fabric, but absent a showing to the contrary, it is the examiner's position that the article of the applied prior art is identical to or only slightly different than the claimed article because the end result is a fabric comprising flattened filaments.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,498,468 to Blaney (as applied to claims 1-2, 4, 6-8, 13, 23 and 25-27 above).

Blaney discloses that fabric maintains permeability (column 1, lines 19-28). In the event that it is shown that the fabric does not inherently possess the claimed permeability, it would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the permeability of the fabric because it is understood by one of ordinary skill in the art that the permeability determines the rate of gas or liquid flow through the fabric, because some applications require higher permeability, and because it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

10. Claims 1-2, 4, 6, 23 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 3,110,905 to Rhodes in view of USPN 6,060,145 to Smith et al. (hereinafter referred to as Smith).

Regarding claims 1-2, 4, 6, 23 and 25-27, Rhodes discloses a tufted fabric comprising flattened filaments (see entire document including column 1, line 71 through column 2, line 50). Rhodes does not specifically mention using the fabric as a supporting fabric, to form a nonwoven product and thereafter removing the nonwoven product from the supporting fabric, but it appears that the fabric is capable of being used as claimed.

Rhodes does not appear to specifically mention a hydroentangling device in combination with the tufted fabric, but Smith discloses that it is known in the tufted fabric art to include a hydroentangled nonwoven secondary carpet backing material for a plurality of reasons including increased delamination strength and increased dimensional stability (see entire document including column 5, lines 3-59, column 8, line 45 through column 9, line 47). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the tufted fabric of Rhodes with a hydroentangling device, because the hydroentangling device would produce the desired secondary backing material which would result in a tufted fabric with increased delamination strength and increased dimensional stability.

Regarding claims 2 and 4, Rhodes discloses that at least one direction (CD or MD) of filaments may include non-flattened filaments (51) (see Figure 1).

Regarding claim 6, Rhodes discloses that the flattened filaments may include a combination of the MD and CD filaments (column 1, line 71 through column 2, line 50).

Regarding claims 23 and 25-27, Rhodes discloses that the flattened filaments may be spun, extruded, or shaped into a flattened or rectangular shape (column 2, lines 33-50) and then woven (column 2, lines 14-16). Absent a showing to the contrary, it is the examiner's position that the article of the applied prior art is identical to or only slightly different than the claimed article. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir.

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1985). The burden has been shifted to the applicant to show obvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). The applied prior art either anticipated or strongly suggested the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the applied prior art.

11. Claims 1, 6, 13-14, 23, 25-27 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,142,752 to Greenway et al. (hereinafter referred to as Greenway) in view of USPN 4,345,730 to Leuvelink.

Regarding claims 1-2, 4, 6-8, 13, 23 and 25-27, Greenway discloses hydroentangling devices in combination with conveyor belts (see entire document including column 4, lines 33-46), but Greenway does not mention specific conveyor belt materials. Greenway is silent with regards to specific conveyor belt materials, therefore, it would have been necessary and thus obvious to look to the prior art for conventional conveyor belt materials. Leuvelink provides this conventional teaching showing that it is known in the conveyor belt art to use a fabric comprising flattened filaments (see entire document including column 4, line 63 through column 5, line 23). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the conveyor belts from the flattened filament fabric of Leuvelink, motivated by the expectation of successfully practicing the invention of Greenway.

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Although Leuvelink does not appear to specifically mention using the fabric as a supporting fabric, to form a nonwoven product and thereafter removing the nonwoven product from the supporting fabric, it appears that the fabric is capable of being used as claimed.

Regarding claim 6, Leuvelink discloses that the flattened filaments may include a combination of the MD and CD filaments (column 5, lines 19-23 and Figure 7).

Regarding claim 13, Leuvelink does not specifically mention the permeability of the fabric, but considering that the fabric disclosed by Leuvelink is substantially identical to the claimed fabric (spiral link fabric comprising flattened filaments), and considering that the applicant discloses that such a fabric inherently possesses the claimed permeability (see page 11, lines 8 and 9 of the current specification), it appears that the fabric inherently possesses the claimed permeability.

Regarding claims 14 and 30, Leuvelink discloses that the fabric may be a spiral link type fabric (see Figure 7).

Regarding claims 23 and 25-27, Leuvelink does not specifically mention how or when in the process the filaments are flattened, but absent a showing to the contrary, it is the examiner's position that the article of the applied prior art is identical to or only slightly different than the claimed article because the end result is a fabric comprising flattened filaments.

Response to Arguments

12. Applicant's arguments filed 8/29/2006 have been fully considered but they are not persuasive.

The applicant asserts that Blaney does not teach or suggest a support fabric comprising flattened filaments. The examiner respectfully disagrees. Blaney discloses a fabric comprising flattened filaments (see entire document including column 5, lines 10-19, column 6, lines 33-37, column 10, lines 1-21 and lines 49-60, and Figures 4, 6, 8 and 10). Blaney does not appear to specifically mention using the fabric as a supporting fabric, to form a nonwoven product and thereafter removing the nonwoven product from the supporting fabric, but it appears that the fabric is capable of being used as claimed. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The applicant has failed to show, or attempt to show, that the intended use recitation results in a structural difference between the claimed invention and the prior art.

The applicant asserts that there is no teaching or suggestion in either Rhodes or Smith for the use of a support fabric in a hydroentangling device. The examiner contends that the claims do not require that the use of a support fabric in a hydroentangling device. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The applicant asserts that if the fabric of Rhodes were used as a support fabric, the high-pressure water would cause overlying fibers to entangle with the fabric, preventing separation of the fibers from the fabric. Firstly, it is well settled that unsupported arguments are no substitute for objective evidence. In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974). Secondly, even assuming *arguendo*, that the high-pressure water would cause overlying fibers to entangle with the fabric, considering that the fibers and the fabric are not permanently adhered together, the fibers would necessarily be removable from the fabric.

The applicant asserts that there is no motivation to combine the teachings of Greenway and Leuvelink because Greenway does not specifically require the belt to possess flattened filaments. The examiner respectfully disagrees. Greenway discloses hydroentangling devices in combination with conveyor belts (see entire document including column 4, lines 33-46), but Greenway does not mention specific conveyor belt materials. Greenway is silent with regards to specific conveyor belt materials, therefore, it would have been necessary and thus obvious to look to the prior art for conventional conveyor belt materials. Leuvelink provides this conventional teaching showing that it is known in the conveyor belt art to use a fabric comprising flattened filaments (see entire document including column 4, line 63 through column 5, line 23). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the conveyor belts from the flattened filament fabric of Leuvelink, motivated by the expectation of successfully practicing the invention of Greenway.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so

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long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

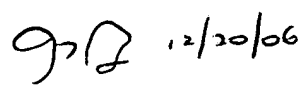
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T. Piziali whose telephone number is (571) 272-1541. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

atp

 12/20/06
ANDREW PIZIALI
PRIMARY EXAMINER